

**REMARKS/ARGUMENTS**

The Office Action mailed June 6, 2005 has been reviewed and carefully considered. Claims 6, 8, and 11 were previously canceled. Claims 1-5, 7, 9-10, and 12 are pending in this application, with claim 1 being the only independent claim. Reconsideration of the above-identified application in view of the following remarks is respectfully requested.

In the Office Action mailed June 6, 2005, claims 1-3, 7, and 9-12 stand rejected under 35 U.S.C. §103 as unpatentable over a product that the Examiner refers to as "Rio Portable MP3 player bundled with MusicMatch Jukebox". The Examiner lists four references labeled A-D to define what the Examiner means by "Rio Portable MP3 player bundled with MusicMatch Jukebox". References A-D are discussed in more detail below.

Claims 4-5 stand rejected under 35 U.S.C. §103 as unpatentable over the "Rio Portable MP3 player bundled with MusicMatch Jukebox" in view of U.S. Patent No. 6,208,335 (Gordon).

References A-D disclose two separate devices: a computer running MusicMatch software and a Rio Portable MP3 player. The Rio player is connectable to the computer running the MusicMatch Jukebox software for downloading playlists of songs from the computer from lists generated by the MusicMatch Jukebox software.

Reference A discloses MusicMatch Jukebox, which is a software product that allows a user to record CDs or download music from the Internet onto a computer running the MusicMatch Jukebox software (page 1, section 1). On page 2, section 3, reference A discloses that the digital track may be stored with a preference rating. There is no further disclosure as to how the preference rating is used or may be used. Reference B is a press release for MusicMatch Jukebox which lists many features of the MusicMatch Jukebox but does not further describe the

preference rating. Reference C is yet another web page describing MusicMatch. The third page of reference C states that the Rio Portable MP3 Player is bundled with MusicMatch.

Reference D discloses the Rio Portable MP3 player. As disclosed on pages 9-10 of Reference D and on page 3 of Reference C, a user records or downloads music using MusicMatch and saves the recorded or downloaded songs on the computer running the MusicMatch software. The user then selects which of the saved songs to save to the Rio Player (see especially the last three lines on page 3 of Reference C which states "Once you've created the perfect MP3 play list for the mood, save it to the Rio player and listen to exactly the music you want wherever you go").

It is respectfully submitted that independent claim 1 is allowable over Rio Portable MP3 player bundled with MusicMatch Jukebox because Rio Portable MP3 player bundled with MusicMatch Jukebox fails to disclose, teach or suggest that the processor on the portable media player is arranged "for receiving the signal from said user-manipulable control, and for associating the user-supplied rating indicated by the signal with the currently played media content", as expressly recited in independent claim 1.

The Examiner acknowledges that Rio Portable MP3 player bundled with MusicMatch Jukebox "does not expressly disclose that it is the processor within the portable media that contains the software for rating and ranking the media content using a user-manipulable control". However, the Examiner alleges that it would have been obvious to include the MusicMatch software for implementing a selection in the processor of the Rio Portable MP3 player. Applicant disagrees with the Examiner's allegation.

As stated in MPEP §2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combines) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The prior art cited by the Examiner fails to provide any teaching, suggestion, or motivation for including the software for rating and ranking media within a portable media player. Only the teachings of the present application disclose that the software for rating and ranking media are included within a portable media player. In contrast, the Rio Portable MP3 player bundled with MusicMatch Jukebox discloses only that the ranking is performed on the computer using the MusicMatch software loaded on the computer. Reference D specifically discloses that the computer with the MusicMatch software is used to control all of the music that is recorded and/or downloaded by a user (see page 8, second and third paragraphs, of reference D). The Rio Portable MP3 player is used only to play back playlists created using the MusicMatch software on the computer (see the paragraph following the heading "2. Rio Software Components", on page 9 of reference D). Since the Rio Portable MP3 player bundled with MusicMatch Jukebox discloses that the Rio Portable Player is used to play music based on playlists created on a computer with the MusicMatch software and that the computer is used to control all of a user's stored music, there is no motivation, teaching, or suggestion for implementing any portion of the MusicMatch software in the processor of the Rio Portable MP3 player.


In view of the above amendments and remarks, it is respectfully submitted that independent claim 1 is allowable over Rio Portable MP3 player bundled with MusicMatch Jukebox.

Dependent claims 2-7, 9-10 and 12, each being dependent on independent claim 1 are allowable for at least the same reasons as is independent claim 1.

Dependent claim 7 recites that the user-manipulable control is incorporated in a headphone cord for headphones which plugs into the portable media player. Support for this limitations is disclosed at page 7, lines 1-5 of the present specification. The "Rio Portable MP3 player bundled with MusicMatch Jukebox" fails to disclose that preferences can be input by a control incorporated in a headphone cord. The Examiner states that the limitation of claim 7 is disclosed by "Rio Portable MP3 player bundled with MusicMatch Jukebox" because the headphone is attached to the portable player and the portable player is attached to the PC using a cord. However, dependent claim 7 specifically recites "wherein the user-manipulable control is incorporated in a headphone cord for headphones which plugs into the portable media player". There is no disclosure teaching or suggestion for user-manipulable control incorporated in a headphone cord, as expressly recited in dependent claim 7. Accordingly, dependent claim 7 is deemed to be allowable for at least these additional reasons.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,  
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Dated: September 6, 2005